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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,742	12/11/2003	Conleth O'Connell	VIGN1640-2	8405
44654	7590	08/22/2007		
SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705			EXAMINER PATEL, HETUL B	
			ART UNIT 2186	PAPER NUMBER
			MAIL DATE 08/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,742

Applicant(s)

O'CONNELL ET AL.

Examiner

Hetul Patel

Art Unit

2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communication filed on August 07, 2007. This amendment has been entered and carefully considered. None of the claims are amended, cancelled or newly added. Therefore, claims 1-43 are currently pending in this application.
2. The declaration filed on August 07, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the D'Orto et al. (USPN: 2004/0107319) reference because it does not establish conception, reduction to practice, or diligence onto constructive reduction to practice.
3. The rejection of claims 1-43 as in the previous office action is respectfully maintained and reiterated below for Applicant's convenience.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-43 are rejected under 35 U.S.C. 102(e) as being anticipated by D'Orto et al. (USPN: 2004/0107319) hereinafter, D'Orto.

As per claim 1, D'Orto teaches a method for updating a cache, comprising regenerating a request from metadata (i.e. the type of data and a frequency at which the source data is updated) associated with content previously stored in the cache, wherein the previously stored content was generated based on a previously received request identical to the generated request and the metadata is stored in conjunction with the previously stored content; receiving new content, wherein the new content is generated based on the request; and replacing the previously stored content with the new content in the cache (e.g. see paragraph [0012] and Figs. 1-4).

As per claim 2, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the method comprising the step of receiving information on updated content (i.e. automatically retrieves the updated data from the data source/server) (e.g. see paragraphs [0004] and [0012]).

As per claim 3, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the request is regenerated in response to the information received (i.e. the request is regenerated based on the frequency a user requests/accesses the information and the frequency at which the source data is updated) (e.g. see paragraph [0012]).

As per claim 4, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the metadata is template metadata or request metadata (i.e. the frequency a user accesses or requests the information) and the information received pertains to the template metadata or the request metadata (e.g. see paragraph [0012]).

As per claims 5 and 6, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the information is received by and regenerated by a cache manager (i.e. 30 in Fig. 1) (e.g. see Fig. 1 and paragraph [0004]).

As per claim 7, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the method further comprising a step of sending the information, wherein the information is sent by an application manager (i.e. the data source, such as web site or in more specific the web server) (e.g. see paragraphs [0002] and [0004]).

As per claim 8, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the information is sent in response to a content change (i.e. based on the frequency at which the source data is updated/changed), metadata change, or template change (e.g. see paragraph [0012]).

As per claim 9, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the information is sent via web pages (e.g. see 26 in Fig. 1). Although D'Orto does not clearly disclose that the information is sent via HTTP or JMS, it is inherent feature that the data/information is transferred between the cache and the web pages/servers via HTTP (i.e. Hyper Text Transfer Protocol) or JMS (i.e. Java Message Service).

As per claim 10, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the method further comprising a step of locating the previously stored content in the cache (i.e. locating the "stale" data and "purging" it as described in paragraphs [0020] and [0025]).

As per claim 11, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the step of locating previously stored content comprises comparing the received information with the template metadata (i.e. the type of data) associated with the previously stored content (e.g. see paragraphs [0020] and [0025]).

As per claim 12, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the step of locating previously stored content comprises comparing the received information with the request metadata (i.e. the frequency a user requests/accesses the information) associated with the previously stored content (e.g. see paragraphs [0020] and [0025]).

As per claim 13, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that regenerating the request is not based on a user request but based on the predetermined conditions (e.g. see paragraph [0025]).

As per claim 14, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that regenerating the request is based on the frequency a user requests/accesses the information and the frequency at which the source data is updated (e.g. see paragraphs [0012] and [0025]). Therefore, D'Orto has to depend on some sort of a timer to regenerate the request based on the frequencies listed above.

As per claim 15, D'Orto teaches the claimed invention as described above and furthermore, D'Orto teaches that the timer is associated with the previously stored data, i.e. associated with the frequency a user requests/accesses the information and the frequency at which the source data is updated; and the previously stored data has to be

associated with it in order to determined the above listed frequencies (e.g. see paragraphs [0012] and [0025]).

As per claims 16-43, see arguments with respect to the rejection of claims 1-4, 7-15 and 1-15, respectively. Claims 16-43 are rejected based on the same rationale as the rejection of claims 1-4, 7-15 and 1-15, respectively.

Response to Arguments

5. Applicant alleges that Applicant is not aware of the requirement(s) (i.e. "Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant") presented by Examiner in the previous office action and respectfully requested Examiner to point out the source of these requirements.

Examiner would like to point out to Applicant that the quoted requirement shown above is disclosed in the last paragraph of MPEP 715.07(I) under Facts and Documentary Evidence.

6. Applicant alleges that at least pages 21-42 of Exhibit A of the submitted three declarations support the claimed limitations. Examiner would like to clarify that the most of the cited pages (i.e. 21-42) contains computer code. There is no clear explanation/showing about which part(s) of this code support(s) each of the pending claims. The Examiner recommends attributing the claimed subject matter to the code itself, or at least the commented header/description sections for each section of the code, in order to properly identifying that the reference discloses all claimed limitations.

7. Applicant submits that a time period of 11 days exhibits diligence as stated in *Broos v. Barton*, 142 F.2d 690. Therefore, this fact combined with the statements in three submitted declarations are sufficient evidence of diligence.

Examiner would like to point out that the *Broos v. Barton* case law is very old (i.e. decision came on April 15, 1944). The MPEP under 2138.06 clearly states "A 2-day period lacking activity has been held to be fatal" according to the (newer) case law *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983). Therefore, Examiner maintains that diligence has not been shown and Applicant has not given any evidence(s) of diligence.

8. The declaration filed on August 07, 2007 under 37 CFR 1.131 has been considered but is still ineffective to overcome the *D'Orto et al.* (USPN: 2004/0107319) reference because

- a. after reviewing the "Cache Document" submitted in Exhibit A,
 - i. it appears that David Caldwell should be the actual inventor of the current application. Page 1 indicates that David Caldwell is the author of the "Cache Document" (emphasis added); and
 - ii. it is unclear which part of the "Cache Document" was drafted by Conleth O'Connell, Mark R. Scheevel and N. Isaac Rajkumar (inventors of the current application).
- b. it does not establish conception, reduction to practice, or diligence onto constructive reduction to practice.

9. As a preliminary matter, it is unclear whether
- applicant is alleging that a reduction to practice occurred prior to December 03, 2002 as implied by the last paragraph on page 8 of the remarks, by stating "the present application was conceived on or before November 20, 2002 (as shown by the O'Connell Declaration, Scheevel Declaration and Rajkumar Declaration), subsequently reduced to practice by the filing of a provisional patent application on December 13, 2002"; or
 - applicant is relying on constructive reduction to practice based on the filing of the application.
10. Both scenarios will be addressed below:

CONCEPTION

11. A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909). Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was

established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.

12. In paragraphs 4 of the O’Connell Declaration, Scheevel Declaration and Rajkumar Declaration, applicant alleges conception and states that the attached Exhibit A supports such conception. This amounts to a vague and general assertion. Applicant has not given a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.

13. There is no explanation of how claims are supported by the disclosed documents. The examiner has reviewed the Exhibit provided and does not find that it supports conception of the claimed invention.

14. In the Remarks, Applicant alleges that at least pages 21-42 of Exhibit A of the submitted three declarations support the claimed limitations. Examiner would like to clarify that the most of the cited pages (i.e. 21-42) contains computer code. There is no explanation/showing about which part(s) of this code support(s) each of the pending

claims. The Examiner recommends attributing the claimed subject matter to the code itself, or at least the commented header/description sections for each section of the code, in order to properly identifying that the reference discloses all claimed limitations.

REDUCTION TO PRACTICE

15. Assuming (as per the second and the last paragraphs on page 8 of the remarks submitted with the affidavits) that applicant is relying on a reduction to practice prior to December 03, 2002 (cited reference date), the affidavit is not sufficient. No evidence of reduction to practice has been provided.

NOTE: In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

DILIGENCE

16. In paragraph 5, applicant alleges that it was diligent from Nov. 20, 2002 up until the filing date of the application, Dec. 13, 2002.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

In the interest of compact prosecution, Examiner makes some comments about what is necessary to prove diligence.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

Mere statements that applicant was diligent without an evidentiary showing is not sufficient.

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975).

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading).

Applicant has not given any evidence(s) of diligence. Therefore, diligence has not been shown.

Conclusion

17. Since all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered earlier. Accordingly, **THIS ACTION IS MADE FINAL**

even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

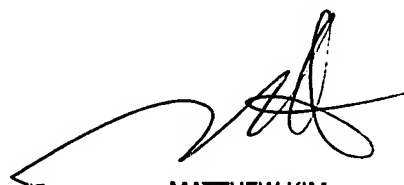
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hetul Patel whose telephone number is 571-272-4184. The examiner can normally be reached on 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HBP/
HBP

A handwritten signature in black ink, appearing to read 'MATTHEW KIM', with a long horizontal stroke extending to the left.

MATTHEW KIM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100